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| 09/916,537 | 07/27/2001 | Tamra L. Thomason | 10004747-1 | 8559 |

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| EXAMINER |
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SAIN, GAUTAM

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| ART UNIT | PAPER NUMBER |
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2176

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/916,537

Applicant(s)

THOMASON, TAMRA L.

Examiner

Gautam Sain

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,7-15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,7-15 and 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

- 1) This is a Final Rejection in response to amendment filed on 5/2/05.
- 2) Applicant amends claim 14, specifically (and thereby the respective dependents).
For said amendments, the Examiner introduces the Lynch reference.
- 3) The effective filing date is 7/2001.

Claim Rejections - 35 USC § 103

- 4) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4-1) Claims 1-3, 5, 7-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy et al (US 6651217, filed Sep 1999), in view of Goheen (US 5724520, issued Mar 1998), further in view of Berger et al (US 6112986, issued Sep 5, 2000).

Claim 1, Kennedy teaches

A method for completing forms, comprising the configuring the user information for merging with the form (ie., autofill form, where user can fill in missing values; the system fills in the values it already has and is ready for input from the user)(col 6, lines 44, 46, 62-67); and merging the user information into the form by population form data fields with pieces of the user information (ie., autofill form, where user can fill in missing values into the form)(col 6, lines 44, 46, 62-67); and

Art Unit: 2176

Kennedy does not teach, but Goheen teaches

Reading a user data card to determine a network location at which user information to be added to a form is stored (ie., upon swiping the card, processing the user card information, payment and validation information from remotely located central computer via cellular network; the network of Goheen consists of many mobile units and the system may determine that a request is made to access information from the central servers)(col 3, lines 1-5; lines 57-58);
retrieving the user information from the network location (ie., remotely located central computer where ATM/mobile units retrieve travelers' reservation stored in the central computer)(col 3, lines 1-5),
printing a hard copy form that contains at least a portion of the user information (ie., printed out with passenger travel information)(col 7, line 43).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kennedy to include a user ID card swipable by an ATM/mobile unit that retrieves passenger information from the central database across a network and prints out the passenger travel information at the mobile/ATM location as taught by Goheen, providing the benefit of a method and apparatus for data management which puts essential information on a credit card-like medium, that is easily scanned into a computer terminal where data is contained at one or more locations (Berger, Abstract). Furthermore, Berger provides the motivation to combine the card identification system to access more information on a user via a mobile unit (Berger, col 4, line 50) and

Art Unit: 2176

completing portions of a form, in order to save time and prevent errors in filling out forms (Berger, col 4, lines 60-67)

Claim 2, Kennedy does not expressly but Goheen teaches

wherein the data card is read by a card reader of a printer that prints the hard copy form such that no separate computer is needed to generate the hard copy form (ie., automated teller system with associated printer)(col 4, lines 37-38).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kennedy to include an automated teller system associated with a printer as taught by Goheen, providing the benefit of a method and apparatus for data management which puts essential information on a credit card-like medium, that is easily scanned into a computer terminal where data is contained at one or more locations (Berger, Abstract). Furthermore, Berger provides the motivation to combine the card identification system to access more information on a user via a mobile unit (Berger, col 4, line 50) and completing portions of a form, in order to save time and prevent errors in filling out forms (Berger, col 4, lines 60-67)

Claim 3, Kennedy teaches

wherein the location information comprises a universal resource locator URL (ie., URL associated)(col 5, line 33).

Claim 5, Kennedy teaches

wherein the network comprises the Internet (ie., forms on the Internet)(col 1, line 10).

Claim 7, Kennedy does not expressly teach, but Goheen teaches

comprising the confirming authorization to access the user information (ie., card identification number and reservation number allows access upon confirmation from the mainframe)(col 4, lines 10-21)(furthermore, the ID number is one way that provides authorized access to information on the passenger)(col 5, lines 55-60).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kennedy to include an automated teller system associated with a printer as taught by Goheen, providing the benefit of a method and apparatus for data management which puts essential information on a credit card-like medium, that is easily scanned into a computer terminal where data is contained at one or more locations (Berger, Abstract). Furthermore, Berger provides the motivation to combine the card identification system to access more information on a user via a mobile unit (Berger, col 4, line 50) and completing portions of a form, in order to save time and prevent errors in filling out forms (Berger, col 4, lines 60-67)

Claim 8, Kennedy does not expressly teach, but Goheen teaches confirming authorization comprises receiving a correct passcode (ie., passenger ID card has an ID number that validates the passenger. Examiner interprets the ID number as analogous to passcode as both are needed to gain access and the user is granted a number on the card)(col 5, lines 50-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kennedy to include an automated teller system associated with a printer as taught by Goheen, providing the benefit of a method and apparatus for data management which puts essential information on a credit card-like medium, that is

Art Unit: 2176

easily scanned into a computer terminal where data is contained at one or more locations (Berger, Abstract). Furthermore, Berger provides the motivation to combine the card identification system to access more information on a user via a mobile unit (Berger, col 4, line 50) and completing portions of a form, in order to save time and prevent errors in filling out forms (Berger, col 4, lines 60-67).

Claim 9, Kennedy teaches

A system for completing forms, comprising means for merging the user information with a form (ie., autofill form, where user can fill in missing values into the form)(col 6, lines 44, 46, 62-67);

Goheen teaches

means for reading location information from a user data card (ie., card reader is means for reading location information from a card when a passenger swipes a card, the system identifies that information is located in the central computer)(col 3, line 58; col 2, line 68);

means for retrieving the user information from a network location identified in the location information (ie., upon swiping card, the ATM identifies the central computer holding the passengers travel information)(col 5, lines 55-60; col 3, lines 1-5);

means for printing a hard copy form that contains at least a portion of the user information (ie., printout with passenger travel info)(col 7, line 43).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kennedy to include a card reader means for reading passenger information on a network where the information resides on the central server and the

Art Unit: 2176

user can get a printout with travel information as taught by Goheen, providing the benefit of a method and apparatus for data management which puts essential information on a credit card-like medium, that is easily scanned into a computer terminal where data is contained at one or more locations (Berger, Abstract). Furthermore, Berger provides the motivation to combine the card identification system to access more information on a user via a mobile unit (Berger, col 4, line 50) and completing portions of a form, in order to save time and prevent errors in filling out forms (Berger, col 4, lines 60-67)

Claim 10, Kennedy does not expressly teach, but Goheen teaches *means for receiving location information comprises a card reader of a printing device. the card reader being that is adapted to read data from a the user data card (ie., automated teller system with printer where a user swipes the card in a card reader)(col 4, lines 37-38; col 3, lines 57-58).*

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kennedy to include a card reader means with a printer as taught by Goheen, providing the benefit of a method and apparatus for data management which puts essential information on a credit card-like medium, that is easily scanned into a computer terminal where data is contained at one or more locations (Berger, Abstract). Furthermore, Berger provides the motivation to combine the card identification system to access more information on a user via a mobile unit (Berger, col 4, line 50) and completing portions of a form, in order to save time and prevent errors in filling out forms (Berger, col 4, lines 60-67)

Art Unit: 2176

Claim 11, Kennedy teaches

wherein the means for retrieving the user information comprises a network interface device (ie., network interface 114)(col 4, line 64)..

Claim 12, Kennedy teaches

wherein the network interface device is adapted to transmit and receive data via the Internet (ie., forms on Internet)(col 1, line 10).

Claim 13, Kennedy teaches

wherein the means for printing a hard copy form comprises a printer (ie., printer)(col 4, line 38).

4-2) Claims 14, 15, 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy et al (US 6651217, filed Sep 1999), in view of Goheen (US 5724520, issued Mar 1998), further in view of Berger et al (US 6112986, issued Sep 5, 2000), further in view of Lynch (US 5852977, issued Dec 29, 1998).

Claim 14, Kennedy teaches

A printing device, comprising:

device memory that stores forms (ie., values for forms are stored at client computer)(col 6, line 28; col 5, line 42);

a form generation module that merges the user information with a form stored in the device memory for the purpose of printing a hard copy form that is at least partially completed (ie., autofill form, where user can fill in missing values into the form where the form can be printed upon completion via the attached printer)(col 6, lines 44, 46, 62-67; col 4, line 48);

Art Unit: 2176

printing hardware with which hard-copy documents can be generated (ie., printer)(col 4, line 48);

Kennedy does not teach, but Goheen teaches

a card reader that is adapted to read location information from a user data

card (ie., upon swiping the card, processing the user card information, payment and validation information from remotely located central computer via cellular network; the network of Goheen consists of many mobile units and the system may determine that a request is made to access information from the central servers)(col 3, lines 1-5; lines 57-58); and

a network interface device that is adapted to retrieve user information from a network location identified in the location information (ie., upon swiping the card, processing the user card information, payment and validation information from remotely located central computer via cellular network; the network of Goheen consists of many mobile units and the system may determine that a request is made to access information from the central servers)(col 3, lines 1-5; lines 57-58);

Kennedy in view of Goheen does not teach, but Lynch does teach the amended portions of the claim regarding the printer device and the printer device memory (ie., a printer (20) to print financial documents such as cheques (which Examiner interprets as forms) upon user inserting a user card)(see Abstract section).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kennedy to include a user ID card swipable by an ATM/mobile unit that retrieves passenger information from the central database across a network and

Art Unit: 2176

prints out the passenger travel information at the mobile/ATM location as taught by Goheen, providing the benefit of a method and apparatus for data management which puts essential information on a credit card-like medium, that is easily scanned into a computer terminal where data is contained at one or more locations (Berger, Abstract). Furthermore, Berger provides the motivation to combine the card identification system to access more information on a user via a mobile unit (Berger, col 4, line 50) and completing portions of a form, in order to save time and prevent errors in filling out forms (Berger, col 4, lines 60-67), further to include a printer to print cheques upon the user inserting a user card as taught by Lynch, providing the benefit of a print means to print on incorrectly printed documents a permanent indication of invalidity from a well known automated teller machine which allows self service dispensing of printed documents, insurance cover notes, loan records (Lynch, col 1, lines 7-13).

Claim 15, Kennedy does not teach, but Goheen teaches

wherein the card reader is adapted to read information from a magnetic strip of the user data card (ie., magnetic bar strip; magnetic card reader)(col 6, line 49; Abstract).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kennedy to include a magnetic strip on a user ID card swipable by an ATM/mobile unit that retrieves passenger information from the central database across a network and prints out the passenger travel information at the mobile/ATM location as taught by Goheen, providing the benefit of a method and apparatus for data management which puts essential information on a credit card-like medium, that is easily scanned into a computer terminal where data is contained at one or more

Art Unit: 2176

locations (Berger, Abstract). Furthermore, Berger provides the motivation to combine the card identification system to access more information on a user via a mobile unit (Berger, col 4, line 50) and completing portions of a form, in order to save time and prevent errors in filling out forms (Berger, col 4, lines 60-67)

Claim 17, Kennedy teaches

further comprising a network browser (ie., internet browser)(col 2, line 28).

Claim 18, Kennedy teaches

wherein the network browser is an Internet browser (ie., internet browser)(col 2, line 28).

Claim 19, Kennedy teaches

wherein the printing device comprises a printer (ie., printer)(col 4, line 48).

Claim 20, Kennedy teaches wherein the printing device comprises a multifunction peripheral (MFP) device (ie., peripheral output device ... printer)(col 4, line 48).

Response to Arguments

5) Applicant's arguments filed 5/2/05 have been fully considered but they are not persuasive. Applicant argues that under MPEP 2143 that there is no suggestion or motivation in the prior art to modify Kennedy reference in the manner suggested in the Office Action (see top of Page 8, Remarks). The Examiner disagrees. First, motivation can be established by showing some objective teaching in the prior art or generally available knowledge to one of ordinary skill in the art that would lead that individual to the claimed invention. The Examiner used the Berger reference as evidence to show the objective motivation to combine the card identification system to access more information on a user via a mobile unit (Berger, col 4, line 50) and completing portions

Art Unit: 2176

of a form, in order to save time and prevent errors in filling out forms (Berger, col 4, lines 60-67). The motivation does not have to be found in the reference themselves, it can be ascertained by knowledge generally available to one of ordinary skill in the art.

The Applicant argues on top of page 10 of the REMARKS that there was no motivation to combine the Kennedy and Goheen references for the Applicant's proposed modification. Specifically, Applicant asserts that there was no motivation to combine the reference to teach "reading a user data card to determine a network location at which user information to be added to a form is stored" and "printing a hard copy form that contains at least a portion of the user information" (see top page 10). Examiner disagrees and asserts that the proposed claimed invention was very well known in the art at the time of the invention. For strictly evidence to support the assertion for that the disputed claimed inventive portions (as state above) were well known in the art, The Examiner introduces the following references within the technical field of endeavor as the proposed claimed invention and the references: A. Lynch (US 5852977, issued Dec 1998)(A self service print terminal which requires user to enter a card, where the machine prints a financial document, a cheque); B. Nair et al (US 549530, issued Dec 1995)(a data card terminal that user enters a card, which is authorized at a remote location and prints a receipt); C. Horst et al (US 4385285, issued May 24, 1983)(A check dispensing terminal that reads an identification card). The Examiner has established the motivation to combine Kennedy and Goheen by showing that the proposed combination was well known in the prior art at the time of the invention.

Applicant's arguments with respect to claim 14 have been considered but are moot in view of the new ground(s) of rejection. The Examiner introduces the Lynch reference to teach the amended portions of the claim and relies on the previously asserted references to teach the unamended limitations.

Conclusion

6) Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gautam Sain whose telephone number is 571-272-4096. The examiner can normally be reached on M-F 9-5 EST.

Art Unit: 2176

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

6.5

GS

William S. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
7/22/2005